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07/886,689

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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07/886,689 05/20/92 MULHAUSER

F-022177049 EXAMINER
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NGUYEN, D ART UNIT	PAPER NUMBER 2
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3308  
DATE MAILED:

12/14/92

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

- (RESTRICTED ONLY)
- ☒ This application has been examined ☐ Responsive to communication filed on \_\_\_\_\_ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire \_\_\_\_\_ month(s), 30 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |   |  |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.        | 2. <input checked="" type="checkbox"/> Notice re Patent Drawing, PTO-948.        |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.             | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____  |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-72 are pending in the application.  
Of the above, claims \_\_\_\_\_ are withdrawn from consideration.
2. ☐ Claims \_\_\_\_\_ have been cancelled.
3. ☐ Claims \_\_\_\_\_ are allowed.
4. ☐ Claims \_\_\_\_\_ are rejected.
5. ☐ Claims \_\_\_\_\_ are objected to.
6. ☒ Claims 1-72 are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on \_\_\_\_\_, has been ☐ approved ☒ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received  
☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-47, drawn to an implantable prosthesis, classified in Class 623, subclass 11.

II. Claims 48-67 and 72, drawn to an apparatus for loading and delivering a pliable implantable prosthesis, classified in Class 604, subclass 19.

III. Claims 68-70, drawn to a method of delivering an implant into the body, classified in Class 623, subclass 66.

IV. Claim 71, drawn to a method of repairing a defect in the body, classified in Class 623, subclass 66.

The inventions are distinct, each from the other because of the following reasons:

The inventions are separate and distinct. There are no relationship between the inventions such as product and process of making the product. Group I is directed toward an implant that does not require using the apparatus claimed. The delivering tool may be used for other prosthesis or implants. The method for repairing the implant does not require frames or rings or meshes.

This application contains claims directed to the following patentably distinct species of the claimed invention:

If Applicant elects invention I, further restriction is

required from these species:

1. Claims 1-11, drawn to an implant with frames,
2. Claims 12-22 and 47, drawn to an implant with rings,
3. Claims 23-30, drawn to an implant with a base and  
barbs,
4. Claims 31-38, drawn to an implant with circular sheets,
5. Claims 39-44, drawn to an implant with anchoring  
portions,
6. Claim 45, drawn to an implant with barrier materials and  
sheets which stimulate inflammatory reactions, plus means for  
detaching the two, and
7. Claim 46, drawn to an implant with sheet that does not  
stimulate postoperative adhesion.

If Applicant elects invention II, further restriction is  
required from these species:

1. Claims 48-64, drawn to an apparatus for loading and  
delivering a pliable implantable prosthesis, the apparatus having  
multiple lumen configurations,
2. Claims 65-67, drawn to a delivery apparatus for a  
trocar cannula, the apparatus having a pliable implantable  
prosthesis wound around an elongated introducer shaft, and
3. Claim 72, drawn to a pre-loaded disposable delivery  
tool for laparoscopic delivery of a mesh prosthesis, the tool  
having a storage chamber for a mesh and means for drawing said

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prosthesis.

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P. § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

A telephone call was made to Mr. Jason Honeyman on December 9, 1992 to request an oral election to the above restriction requirement, but did not result in an election being made.

Serial No. 07/886,689

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Any inquiry concerning this communication should be directed to D. Nguyen at telephone number (703) 308-0858.

*D. Nguyen*

D. Nguyen  
December 09, 1992

*R. Green*

RANDALL L. GREEN  
SPE  
ART UNIT 338